

### **REMARKS**

The applicant has carefully considered the Office action dated January 24, 2005 and the references it cites. By way of this Response, claims 242, 253, 263, 275 and 287 have been amended, and new claims 317-440 have been added. In view of the following, it is respectfully submitted that all pending claims are in condition for allowance and favorable reconsideration is respectfully requested.

As a preliminary matter, the applicant notes that a new power of attorney is being submitted herewith and requests that the Office correct the correspondence address for this matter.

Before addressing the issues raised in the Office action, the applicant notes that a number of interviews have taken place concerning this application since last summer. In particular, after filing the Response of July 2, 2004, the undersigned telephoned Examiner Nguyen on July 21, 2004 to confirm that the Response had been received. Examiner Nguyen indicated that he had looked at the amended claims as presented on July 2, 2004 and confirmed that those claims were patentable over the cited art. He also indicated that a further search would be performed, that he had sent the file into central processing to have the amendment entered, and that he was not required to act on the case until September 2, 2004.

Because at the conclusion of the personal interview of June 30, 2004 (discussed in applicant's Response of July 2, 2004) Examiner Smith (Examiner Nguyen's supervisor) had instructed the undersigned to fax the response to Examiner Nguyen and instructed Examiner Nguyen to act on the case without sending the case to central processing to avoid further delay, the

undersigned left a voicemail message for Examiner Smith requesting a return phone call to discuss this additional delay.

On July 27, 2004, Examiner Smith returned the undersigned's call. Examiner Smith indicated that he had retrieved the file and would require Examiner Nguyen to act on the case in an expedited manner. He also indicated that he would discuss the application with Examiner Nguyen and Supervisor Vincent Millen.

Having received no further word, on August 26, 2004, the undersigned left a voicemail message for Examiner Smith requesting a status update. Examiner Smith returned the call and indicated that Examiner Nguyen should act on the application shortly.

The undersigned learned of the Office action of October 15, 2004 on October 18, 2004 from the USPTO's PAIR system. Because that Office action was completely inappropriate, the undersigned telephoned Examiner Smith and requested his review of the situation.

On October 21, 2004, Examiner Coggins (Examiner Smith's supervisor) telephoned the undersigned. Examiner Coggins apologized for the inappropriate Office action of October 15, 2004 and indicated that Examiner Nguyen was being assigned to a different art unit. She also indicated that one of her best examiners (Examiner Zurita) was being assigned to this application in place of Examiner Nguyen. She indicated that the October 15, 2004 Office action would be withdrawn and that the undersigned would receive a phone call from Examiner Zurita shortly.

On October 29, 2004, the undersigned left a voicemail message for Examiner Zurita requesting an update as to the expected time frame for further

action. The undersigned offered to come to the PTO for a personal interview if it would expedite the examination of this case.

On November 2, 2004, Examiner Zurita telephoned the undersigned. The undersigned again offered to travel to Washington for a personal interview to facilitate examination of the application. Examiner Zurita indicated that he would review the application and get back to the undersigned with any questions, and that a personal interview would be premature until he had time to complete his review of the application.

On November 3, 2004, Examiner Zurita telephoned the undersigned and requested a soft copy of the claims pending in the application. The undersigned emailed the soft copy of the claims to Examiner Zurita that day as requested.

On November 4, 2004, Examiner Zurita called the undersigned and asked a number of questions about the disclosure of the application. The Examiner also indicated that he was knowledgeable of efforts to monitor computer usage due to his work experience prior to becoming a patent examiner. In particular, the Examiner mentioned that he was very familiar with work by General Electric (he mentioned the "Business Pro" product, the "Actra" product, the "Informex" database), and was also aware that Netcount, I/Pro, and PCNet were active in the monitoring area. The undersigned indicated that he would seek and provide answers to the questions raised by the Examiner.

On November 8, 2004, the undersigned telephoned the Examiner to discuss the appropriate disclaimer language to add to the document containing

the answers to the Examiner's questions to prevent those answers from being improperly used to narrow the claims by an unscrupulous infringer.

On November 9, 2004, the undersigned added the language recommended by the Examiner to the document containing the answers to the Examiner's questions and forwarded that document to Examiner Zurita via email. Examiner Zurita and the undersigned also held a telephonic interview on November 9, 2004 in which the answers to the Examiner's questions were discussed. In this conversation, the Examiner indicated he would issue an interview summary indicating that the restriction requirement of October 15, 2004 was vacated.

The undersigned telephoned Examiner Zurita on December 20, 2004 to inquire as to the status of this application. Examiner Zurita's voicemail message indicated he was on vacation until December 26, 2004.

The undersigned again telephoned the Examiner on January 3, 2005 and left a voicemail requesting a return phone call. Examiner Zurita returned this call on January 4, 2005 and indicated that he needed more time to complete his review of the art.

On January 6, 2005, Examiner Zurita telephoned the undersigned and indicated he had prepared a new Office action, which, to expedite discussion, the Examiner provided to the undersigned via email. Subsequently, the undersigned contacted Examiner Zurita to schedule a personal interview for January 13, 2005. In response to Examiner Zurita's request, the undersigned provided the agenda attached hereto as Exhibit A for the interview.

Kim Jacklin, the Chief Patent Counsel for Nielsen Media Research, and the undersigned met with Examiner Zurita on January 13, 2005 at the

USPTO. During that meeting, the state of the art as reflected in the articles cited in the Office action of January 24, 2005 was discussed.

During the interview of January 13, 2005, Dedrick, U.S. Patent 5,724,521, and the manner in which the claims in this Response<sup>1</sup> patentably distinguish Dedrick were also discussed. It was agreed that the claims distinguished the art of record. However, Examiner Zurita indicated that he needed to perform some additional prior art searching before deciding on the patentability of the proposed claims. Examiner Zurita also provided the undersigned with copies of additional references for further consideration. Those references are identified on the PTO-1449 form submitted with the information disclosure statement filed on June 13, 2005.

On January 24, 2005, the undersigned telephoned Examiner Zurita to determine if he had completed the additional searching. Examiner Zurita requested the undersigned to search for relevant prior art related to the Real Server product of Real Network. He also instructed the undersigned to file a written response to the Office action of January 24, 2005 and indicated that he would return to examining this application upon the filing of such a written Response.

In response to the Examiner's request, a computer based search was conducted for any relevant prior art pertaining to Real Network and the Real Server product.

The results of the search for Real Network prior art has failed to uncover any prior art that negatively impacts the patentability of the claims

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<sup>1</sup> New dependent claims 328-440 were drafted after the interview of January 13, 2005 and, thus, were not presented at that time.

presented in this Response. Copies of the Real Network references are identified in the information disclosure statement filed on June 13, 2005 so that the Examiner can independently evaluate this art.

Turning now to the Office action of January 24, 2005, as discussed at the interview of January 13, 2005, the claims presented in this Response are patentable over Dedrick. For example, as discussed at the interview, independent claim 242 recites a system comprising, among other things, a remote site which did not transfer the content file from the content provider site to the content display site to receive the monitoring information generated at the content display site. Dedrick does not teach or suggest such a remote site. Thus, claim 242 and all claims depending therefrom are allowable.

Independent claim 253 recites a system comprising, among other things, a remote site which did not deliver the content file to the content display site to receive the data signal generated by the content display site. Dedrick does not teach or suggest such a remote site. Thus, claim 253 and all claims depending therefrom are allowable.

Independent claim 263 recites a system comprising, among other things, a remote site which did not provide the content file to the content display site to receive the data signal generated by the content display site. Dedrick does not teach or suggest such a remote site. Thus, claim 263 and all claims depending therefrom are allowable.

Independent claim 275 recites a method comprising, among other things, transmitting the data signal to a remote site which did not transfer the content file from the content provider site to the content display site. Dedrick

does not teach or suggest such a method. Thus, claim 275 and all claims depending therefrom are allowable.

Independent claim 287 recites a computer readable medium comprising, among other things, at least one computer executable instruction that, when executed, causes data indicating the content was displayed to be transmitted to a remote site which did not supply the file. Dedrick does not teach or suggest such an instruction. Thus, claim 287 and all claims depending therefrom are allowable.

Independent claim 313 recites an article of manufacture comprising, among other things, a computer executable monitoring instruction associated with a display instruction such that the monitoring instruction is executed to monitor the display when the image is displayed and such that the monitoring instruction is not executed when the image is not displayed. Dedrick does not teach or suggest such an instruction. Thus, claim 313 and all claims depending therefrom are allowable.

Independent claim 314 recites an article of manufacture wherein a monitoring instruction and a display instruction are embedded in an HTML file such that the monitoring instruction is only executed when the HTML file is executed to display the image. Dedrick does not teach or suggest such an article of manufacture. Thus, claim 314 and all claims depending therefrom are allowable.

Independent claim 315 recites an article of manufacture wherein a display instruction is embedded in an HTML file and a monitoring instruction is referenced by the HTML file such that the monitoring instruction is only executed when the HTML file is executed to display the image. Dedrick does

not teach or suggest such an article of manufacture. Thus, claim 315 and all claims depending therefrom are allowable.

Independent claim 317 recites a method comprising, among other things, transmitting a data signal from a content display site to a remote site which did not transfer the HTML file from the content provider site to the content display site. Dedrick does not teach or suggest such a method. Thus, claim 317 and all claims depending therefrom are allowable.

Independent claim 318 recites a system comprising, among other things, (a) a first content provider site that stores a first content file associated with at least one computer readable instruction to cause a request for a second content file; (b) a second content provider site that stores the second content file, wherein the second content file is associated with at least one computer readable monitoring instruction to cause generation of monitoring information about the display of the content associated with the second content file; and (c) a content display site to display the content associated with the first content file and the content associated with the second content file substantially simultaneously on a same display, wherein the content display site executes the at least one computer readable monitoring instruction when the second content file is accessed, thereby causing monitoring information about the display of the content associated with the second content file to be collected. Dedrick does not teach or suggest such a method. Thus, claim 318 and all claims depending therefrom are allowable.

Independent claim 320 recites a method comprising, among other things, at least one computer readable instruction for transferring monitoring information to a second server which did not transfer the HTML file to the



client. Dedrick does not teach or suggest such a method. Thus, claim 320 and all claims depending therefrom are allowable.

Independent claim 325 recites a method comprising, among other things, receiving a report from a data collection server concerning the user events of first and second clients with respect to copies of an HTML file that include a computer executable monitoring instruction to generate monitoring information concerning the user events relating to a web page associated with the HTML file and a computer executable transfer instruction to transfer the monitoring instruction to a data collection server. Dedrick does not teach or suggest such a method. Thus, claim 325 and all claims depending therefrom are allowable.

Accordingly, it is respectfully submitted that the rejections based on Dedrick should be withdrawn, and this application is in condition for allowance.

Before closing, the applicant notes that at least the following amendments are either broadening or clarifying and, thus, not necessary for patentability:

1. The addition of the phrase “which is” to claims 242, 253 (both instances), and 275;
2. The addition of the phrase “associated with the content file” to claim 253;
3. The amendments to the phrase “when the content file is accessed” in claim 263;
4. The addition of the phrase “to the content display site” to the last clause of claim 263; and

5. The deletion of the word "content" from claim 287.

The above noted amendments are being made for clarification or broadening purposes only, and are not intended to further limit the scope of the claims in any way. These amendments are merely explicitly stating what was already implicit in the claims and/or broadening the scope of a respective claim. Consequently, these broadening or clarifying amendments do not give rise to prosecution history estoppel or limit the scope of equivalents of the claims under the doctrine of equivalents.

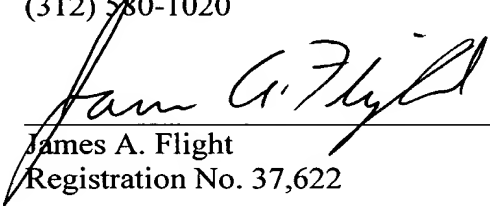
If the Examiner is of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is invited to contact the undersigned at the number identified below.

If any fees are due in connection with this response, please charge them to deposit account no. 50-2455.

Respectfully submitted,

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